



Confirmation No. 3592

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Wollenberg et al.

Examiner: M. Wallenhorst

Serial No.: 10/699,510

Group: Art Unit 1743

Filing Date: October 31, 2003

Docket: T-6298A (538-60)

For: HIGH THROUGHPUT SCREENING
METHODS FOR LUBRICATING OIL
COMPOSITIONS

Dated: July 26, 2006

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

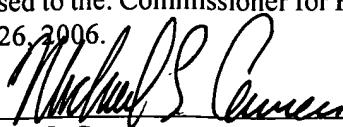
Sir:

In response to the Examiner's Answer mailed May 31, 2006, Appellants respectfully submit that based on at least the arguments provided in the Appeal Brief of May 5, 2006, appealed Claims 1-37 are patentable over the applied references. The following comments are respectfully submitted in order to address statements made in the Examiner's Answer.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 (a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: Commissioner for Patents, Alexandria, VA 22313-1450, Mail Stop Appeal Brief-Patents on July 26, 2006.

Dated: July 26, 2006


Michael E. Carmen



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the art of lubricating oils would not look to a reference directed to deposition of an organic material onto a semiconductor device by way of a carrier gas to arrive at a method and system for preparing a plurality of lubricating oil formulations. In point of fact, there is no suggestion, motivation or even a hint in Shtein et al. of a system for automatically depositing a liquid much less a lubricating oil composition. Thus, nothing in Shtein et al. would lead one skilled in the art to modify the method and system of Kolosov et al. and arrive at the presently claimed invention. In fact, even by combining Shtein et al. with Kolosov et al., one skilled in the art would not even arrive at the method and system as recited in appealed Claims 5 and 23-37. Only by using Appellants' disclosure as a guide has the Examiner been able to piece together the claimed invention. As such, the Examiner has utterly failed to establish the motivation to combine Kolosov et al. and Shtein et al. and arrive at Appellants claimed invention.

Since Kolosov et al., alone or in combination with Shtein et al., do not disclose or suggest the method and system for preparing a plurality of lubricant oil formulations, under program control, as recited in appealed Claims 5 and 23-37, appealed Claims 5 and 23-37 are nonobvious over Kolosov et al. and Shtein et al. Accordingly, appealed Claims 5 and 23-37 are allowable.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. §§1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-3591. **TWO (2) COPIES OF THIS SHEET ARE ENCLOSED.**

Dated: July 26, 2006

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In the Examiner’s Answer, the Examiner withdrew the rejection of Claims 5 and 23-35 as being rejected under 35 U.S.C. §103 (a) over Kolosov et al. alone (stating on page 3 of the Examiner’s Answer that appealed Claims 1-4 and 6-22 were rejected as being obvious over Kolosov et al.) and instead issued a new ground of rejection by rejecting appealed Claims 5 and 23-37 as being obvious over Kolosov et al. in view of Shtein et al. Appellants respectfully traverse the new ground of rejection.

As acknowledged by the Examiner in the Examiner’s Answer, Kolosov et al. fail to teach of a method and system for preparing a plurality of lubricant oil formulations, under program control, which comprises, *inter alia*, “combining selected quantities of the at least one base oil of lubricating viscosity with selected quantities of the at least one lubricating oil additive to form a plurality of lubricating oil composition samples” as generally recited in appealed Claims 5 and 23.

In order to cure the deficiencies of Kolosov et al., the Examiner alleges that “It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use a dispensing means having a mixing chamber connected to a nozzle, similar to the configuration taught by Shtein et al, in the apparatus and method of Kolosov et al so that a lubricating base oil can be combined with an additive prior to dispensing into one of the test receptacles or wells on the substrate, since Kolosov et al teach that any type of known dispensing apparatus may be used to deposit the samples on the substrate (see paragraph no. 0053 in Kolosov et al), and the *use* of the dispenser taught by Shtein et al would allow the fluids and additive materials to be both mixed and dispensed in a single operation, thus allowing the high-throughput method of Kolosov et al to be performed even quicker and more efficiently.” [emphasis added].

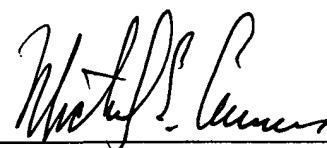
However, it is well established that there must be some teaching, motivation or suggestion to select and combine references relied upon as evidence of obviousness. *In re Lee*, 277 F.3d 1338, 1342-43, 61 USPQ2d 1430, 1433-34 (CAFC 2002). Shtein et al. do not cure the above-noted deficiencies of Kolosov et al. Rather, Shtein et al. simply disclose depositing an organic material onto a semiconductor device by way of a carrier gas. Certainly, one skilled in

the art of lubricating oils would not look to a reference directed to deposition of an organic material onto a semiconductor device by way of a carrier gas to arrive at a method and system for preparing a plurality of lubricating oil formulations. In point of fact, there is no suggestion, motivation or even a hint in Shtein et al. of a system for automatically depositing a liquid much less a lubricating oil composition. Thus, nothing in Shtein et al. would lead one skilled in the art to modify the method and system of Kolosov et al. and arrive at the presently claimed invention. In fact, even by combining Shtein et al. with Kolosov et al., one skilled in the art would not even arrive at the method and system as recited in appealed Claims 5 and 23-37. Only by using Appellants' disclosure as a guide has the Examiner been able to piece together the claimed invention. As such, the Examiner has utterly failed to establish the motivation to combine Kolosov et al. and Shtein et al. and arrive at Appellants claimed invention.

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